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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,629	09/30/2005	Katja Berg-Schultz	K2315USWO (C038435)	2024

7590 08/07/2007  
Stephen M Haracz  
Bryan Cave  
1290 Avenue of the Americas  
New York, NY 10104

EXAMINER
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MATOCHIK, THOMAS L

ART UNIT	PAPER NUMBER
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1709

MAIL DATE	DELIVERY MODE
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08/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/521,629

**Applicant(s)**

BERG-SCHULTZ ET AL.

**Examiner**

Thomas Matochik

**Art Unit**

1709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-11, 13 and 14 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Group I in the reply filed on 6/29/2007 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 7-11, 13 and 14 are withdrawn from consideration in view of the elected claims.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Lenick (US 6,346,595).

Regarding claim 1: O'Lenick teaches trimethylsilyl and trimethylsiloxyl endstopped polysiloxanes can be co-polymerized with UV absorbing, lipophilic , and hydrophilic groups producing novel polymeric sunscreen agents having a general structure shown in the formula (col. 3, lines 55-65). Specifically, the UV absorber employed is eugenol (col. 4, lines 1-5), a lipophilic constituent consisting of a linear alkyl group between C<sub>11</sub> and C<sub>21</sub> carbons (col. 4, line 14), and a hydrophilic moiety of alkoxylated alcohols (col. 4, lines 16-18).

Regarding claim 2: O'Lenick teaches the number of UV absorbing siloxane units is between 1 and 20 (col. 4, line 11).

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Regarding claim 3: O'lenick teaches a polymer whereby there are no units containing a hydrophilic group; i.e.  $c=0$  (col. 4, lines 25 and 26).

Regarding claim 4: The claim is rejected since the presence of the structural feature is optional in the independent claim.

Regarding claim 5: O'Lenick teaches the use of a single species, eugenol, as the UV absorbing component of the polymer (col. 4, lines 20-21).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

O'Lenick teaches the basic claimed composition as set forth above.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Lenick (US 6,346,595) as applied to claim 1-5 above, and further in view of Gonzenbach et.al (US 6,123,929).

Regarding claim 6: O'Lenick does not teach two different UV absorbing species in the same molecule. However, Gonzenbach teaches that two different UV absorbing species can be bonded to a molecule of polymer using the same hydrosilation chemistry (col. 8, Example 2). O'Lenick and Gonzenbach are analogous art since they both are from the same field of endeavor, namely polymeric sunscreen agents. One of ordinary skill in the art at the time the invention was made would have been

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motivated to incorporate different UV absorbing species into the polymer to achieve optimal wavelengths ranges.

### ***Correspondence***

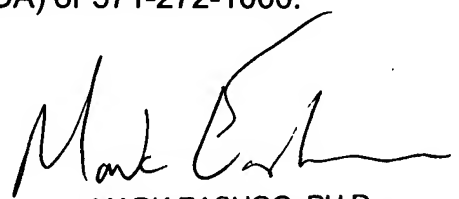
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Matochik whose telephone number is 571-270-3291. The examiner can normally be reached on Monday-Friday 7:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TLM

7/30/2007

  
MARK EASHOO, PH.D.  
SUPERVISORY PATENT EXAMINER

02/Aug/07